

REMARKS

Claims 1-60 stand finally rejected. No claim amendments are made with this Amendment After Final. Claims 1-60 remain pending.

FINAL REJECTION

Applicant respectfully requests reconsideration of the arguments filed April 24, 2006 in light of the following discussion.. Applicant respectfully submits that insufficient weight has been given to his arguments for patentability of the current claims. Applicant respectfully requests reconsideration because the amended claims are patentable over the cited art.

DOUBLE PATENTING REJECTION

Claims 1-7 and 9-43 remain rejected for "double patenting" over claims 1-60 of the Wilson reference (U.S. Patent No. 6,620,871). Applicants respectfully traverse the rejection for the reasons discussed in the previous reply and request reconsideration.

The final rejection states the rejection nearly identically to that of the first Office Action. Specifically, at page 5, line 6 of the final Office Action, it states that "the patented invention includes less than 3 phr of a non-petroleum oil".

Applicant has studied the '871 patent and the claims, and sees no disclosure in the cited reference of "less than 3 phr of a non-petroleum oil". The Examiner is urged to withdraw the double patenting rejection. In the alternative, the Examiner is respectfully requested to point out where in the reference the supposed teaching of "3 phr of a non-petroleum oil" is to be found.

As developed in the reply of April 24, the '871 patent does not disclose or claim at least one limitation of the current claims, that being the presence of a non-petroleum oil. In this light, Applicants respectfully note that claim 1 was previously amended to recite that the non-

petroleum oil is “present at a level of 5 phr or less”. According to the plain language of the claims, the non-petroleum oil is present in the moldable rubber composition. This necessarily means that the amount of the non-petroleum oil is non-zero; otherwise the oil would not be “present”. Read in this light, claim 1 as amended recites a limitation that is not to be found in the ‘871 cited reference. The other main claims (claim 16, 28, 35, 44, and 54) all recite, in various ways, compositions and the like containing non-zero values of the non-petroleum oil. Such a limitation is completely missing from the disclosure and claims of the cited reference.

For the above reasons, and as developed in their reply to the non-final Office Action, Applicant respectfully requests the double patenting rejection over the ‘871 patent be withdrawn.

Claims 1-60 are rejected for obviousness type double patenting over claims 1-60 of the ‘871 patent and further in view of the Teratani (U.S. Patent 5,001,185) and the Hakuta reference (PGPUB No. 2003/0096904). The final rejection repeats the rejection of the non-final Office Action, and does not address Applicant’s statements in his previous reply.

As developed in the amendment to the non-final Office Action of April 24, 2006, the Teratani reference does not disclose rubber compositions containing non-petroleum oils as recited in the current claims. Rather, the reference discusses a “process oil” without further definition and a novolak type phenolic resin modified with an oil. Neither of these amount to a disclosure or suggestion to use the unsaturated vegetable oils of the current claims.

Likewise, the Hakuta reference does not disclose the use of an unsaturated oil. As developed by Applicant in his reply of April 24, the Hakuta reference at paragraph 569 does not disclose the use of castor oil as a dripping inhibitor. Rather, the disclosure is of hydrogenated castor oil. As is well known to those of skill in the art, hydrogenated castor oil is saturated and does not contain the level of unsaturation recited in the current claims.

For these reasons, Applicant respectfully requests that the obviousness type double patenting rejection of claims 1-60 be withdrawn.

NON-PETROLEUM OIL IS PRESENT IN THE CLAIMS

As developed above, Applicants amended claim 1 to recite that a moldable rubber composition comprises non-petroleum oil “present at a level of 5 phr or less”. As developed above, the word “present” in the claim indicates that the non-petroleum oil is in the composition at a non-zero value. If, as suggested by the Examiner on page 7 of the final Office Action, the petroleum oil were “present” at a phr of 0.0, the oil would not be “present”, but rather “absent”. Because every claim term must be given patentable weight, Applicant respectfully submits that the amended claim excludes compositions that contain no non-petroleum oil, as in the cited art.

As further noted above, the other main claims (claims 16, 28, 35, 44, and 54) contain unambiguous statements that the non-petroleum oil is present in the claimed subject matter at non-zero values. Such a feature (presence of unsaturated non-petroleum oil) is neither disclosed nor suggested by the cited art of record. Accordingly, Applicant respectfully requests the rejections be withdrawn.

CONCLUSION

For the reasons discussed above, Applicant believes that claims 1-60 are patentable over the cited references and respectfully request an early Notice of Allowance. Consideration of the above remarks is permissible after a final rejection because they put the claims into condition for allowance and do not require further examination. Further, Applicants believe their earlier comments have not been accorded appropriate weight. Further and favorable consideration is earnestly solicited.

In the alternative, Applicant respectfully requests an Advisory Action stating whether the remarks can be considered after final rejection.

The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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